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PATENT APPLICATION

ATTORNEY DOCKET NO. 10019417-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Hamilton et al.  
Application No.: 09/942,503  
Filing Date: 08/29/2001

Confirmation No.: 8040  
Examiner: Worku, Negussie  
Group Art Unit: 2625

Title: Acquisition and Organization of Digital Images

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 07/21/06

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

- |                                             |                                             |                                              |                                              |
|---------------------------------------------|---------------------------------------------|----------------------------------------------|----------------------------------------------|
| <input type="checkbox"/> 1st Month<br>\$120 | <input type="checkbox"/> 2nd Month<br>\$450 | <input type="checkbox"/> 3rd Month<br>\$1020 | <input type="checkbox"/> 4th Month<br>\$1590 |
|---------------------------------------------|---------------------------------------------|----------------------------------------------|----------------------------------------------|

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	: 09/942,503	)
Conf. No.	: 8040	)
Appellant	: Hamilton et al.	)
Filed	: 08/29/2001	)
Title	: Acquisition and Organization of Digital Images	)
		)
		)
TC / Art Unit	: 2625	)
Examiner	: Worku, Negussie	)
		)
Docket No.	: 10019417-1	)
Customer No.	: 022879	)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANTS' APPEAL BRIEF**

Sir:

Appellants are appealing from the Final Rejection of claims 1-9, 11-25, 27-38, and 41 in an Office Action dated 03/23/2006 and maintained in an Advisory Action dated 06/23/2006.

**I. REAL PARTY IN INTEREST**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of

HPDC is HPQ Holding, LLC.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to the real party in interest which will directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

## **III. STATUS OF CLAIMS**

Claims 1-9, 11-25, 27-38, and 41 are pending. All of claims 1-9, 11-25, 27-38, and 41 stand finally rejected. The Appellants appeal the final rejection of claims 1-9, 11-25, 27-38, and 41.

## **IV. STATUS OF AMENDMENTS**

On 05/19/2006 a response after final rejection was filed that requested reconsideration. No amendment was made to the claims. In an Advisory Action of 06/23/2006, the Examiner indicated that the request for reconsideration filed on 05/19/2006 had been considered and the final rejection maintained as to all pending claims.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The claimed subject matter relates to an image processing system. In one embodiment of an image processing system 10, and with reference to Fig. 1, an image capture subsystem 30 may acquire digital image data from an image source 20, such as an optical scanner 24 (Fig. 2), or a multifunction printer 25 (Fig. 2) that includes an optical scanner subsystem. A date may be associated with the digital image data. In one embodiment in which the digital image data is from a "prerecorded" image source 20b, such as a memory card in a digital

camera 21a (Fig. 2), the date may be the date on which the image data was recorded by the source 20b. In another embodiment in which the digital image data is from a “live” image source 20a, such as the optical scanner 24, the date may be the current date on which the scanning is performed, and which can be provided to the image capture subsystem 30 from a date subsystem 32. In operation, and with reference to Figs. 4 and 6, at 102 the digital image data is acquired from the image source 20. As part of the acquisition process 102, the digital image data is captured 126 or preprocessed 132 according to predefined settings for scanning parameters, such as exemplary parameters 140 (Fig. 7), that are appropriate to a photographic image. Such predefined settings appropriate to a photographic image may include, for example, a pixel depth 142 of 24-bit color; an image resolution 144 of 150 dots per inch (dpi); a crop mode 146 of automatic border detection; and a skew correction mode 148 of automatic image straightening. However, these predefined settings are not defined by the user of the image processing system 10. After the digital image data has been acquired 102, the appropriate date is associated 104 with the digital image data, and the digital image data is converted 106 into a data file and stored 108 on a file system 40, automatically and without intervention by a user. For image sources such as the optical scanner 24 or multifunction printer 25, digital image data can advantageously be acquired more quickly and easily than in previous systems, because there is no need for the user to determine and manually adjust the scanning parameter settings in conjunction with a preview of the captured image before the digital image data is acquired.

In another embodiment, and with reference to the exemplary computer monitor display of Fig. 3, the digital image data file is stored into a folder 42 of the file system 40. The folder 42 has a folder name that is indicative of the date associated with the digital image. In some embodiments, the folder name may be indicative of a particular month and year. For example, the exemplary computer monitor display view 60 illustrates data folders 42a-b in a folder window 62, and thumbnail views of image files 64a-b in a file window 66. Data folder 42a has the folder name of “Jul 2001”, indicative of the month and year of July, 2001. Similarly, data folder 42b has the folder name of “Aug 2001”, indicative of the month and year of August, 2001. In operation, if a date of July 15, 2001 is associated with an acquired

digital image, then the digital image data file will be stored into folder 42a, which has the folder name of "Jul 2001". If a date of August 23, 2001 is associated with an acquired digital image, then the digital image data file will be stored into folder 42b, which has the folder name of "Aug 2001". If no folder 42 having a folder name indicative of the date as yet exists, such a folder 42 will be created as needed. This folder naming and image storing scheme advantageously organizes the digital images by date, thus allowing the user to easily and quickly locate desired images for viewing or post-processing.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-9, 11-25, 27-38, and 41 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent application publication 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,034,785 to Itoh ("Itoh").

Claims 11-14, 16-25, 27-31, 34-35, 37, and 41 stand or fall together.

Claim 15 stands or falls alone.

Claim 32 stands or falls alone.

Claim 33 stands or falls alone.

Claims 1-3, 5-9, 36, and 38 stand or fall together.

Claim 4 stands or falls alone.

## **VII. ARGUMENT**

**A. Claims 11-14, 16-25, 27-31, 34-35, 37, and 41 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent application publication 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,034,785 to Itoh ("Itoh").**

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has

the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

Appellants contend that claims 11-14, 16-25, 27-31, 34-35, 37, and 41 were improperly rejected because (1) the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations; and (2) there is no suggestion or motivation to modify or combine reference teachings.

1. The cited references, alone or in combination, do not teach or suggest all the limitations of the claims in that the limitation of storing an image in a data folder of a file system, where the folder has a folder name that is indicative of a date associated with the image, is absent from the references.

Independent claim 11 recites:

“11. A method of automatically organizing digital images, comprising:  
 acquiring a digital image from an image source;  
 automatically associating a date with the digital image;  
 automatically converting the digital image into a data file; and  
storing the data file into a folder of a file system, the folder having a folder name indicative of the date.” (emphasis added)

There is no teaching or suggestion in either the Nagarajan reference or the Itoh

reference, taken alone or in combination, of storing the data file into a folder of a file system, where the folder has a folder name that is indicative of a date that is associated with the digital image. With regard to this feature, it can be seen in Fig. 3 of the present application, for example, that folder 42a has a folder name of “Jul 2001”, and that folder 42b has a folder name of “Aug 2001”, folder names that are indicative of a date associated with the digital image. As explained with reference to Figs. 3 and 4 of the present application:

“At 108, the data file is stored into a data folder, such as folder 42, of a file system 40. The folder 42 is associated with the date, and typically selected from a set of data folders. If no folder 42 associated with the date as yet exists on the file system 40, such a folder 42 is created. In the preferred embodiment, the data folder is associated with a particular month and year, such as folder 42a for July 2001 and folder 42b for August 2001. For example, for a particular digital image that has a capture date of Jul. 15, 2001 and a storage date of Aug. 23, 2001, if the associated date is the capture date, the image file will be stored into the July 2001 folder 42a, alternatively, if the associated date is the storage date, the image file will be stored into the August 2001 folder 42b. Such a folder organization advantageously organizes the digital images by date, thus helping the user to easily and quickly locate desired images for viewing or post-processing.” (p.11, lines 10-20)

In the rejection of claim 11, the Examiner states that the Nagarajan reference teaches “storing the data file into a folder of a file system, the folder associated with the data (the overall function of the imaging system 30 of fig 1, controlled by computing unit 110 of fig 1, including storing data file)” (Final Office Action, p.6; emphasis added).

Appellants respectfully disagree. The cited elements of Fig. 1 – imaging system 30, and computing unit 110 – do not teach or suggest the recited limitation of “storing the data file into a folder of a file system, the folder having a folder name indicative of the date”. Nowhere in Fig. 1, or anywhere else in the Nagarajan reference, is a file system folder name disclosed in any form, much less in the form of a folder name that is indicative of a date that is automatically associated with the digital image.

In addition, even assuming arguendo that the reference somehow teaches a folder associated with the date, as stated by the Examiner and which Appellants do not concede, such a limitation is different from the limitations that are recited in claim 11. It is noted that claim 11 recites that the folder has a folder name that is indicative of the date associated with the digital image.

Independent claims 27, 35, 37, and 41 each recite a similar folder name limitation as claim 11, and are traversed for similar reasons as argued above for claim 11. In rejecting various ones of these claims, the Examiner cites with regard to this limitation that “memory 100 store data file into a data folder, computer 50 associate with date” (claim 35); “memory 100 of fig 1 stores data file” (claim 37); “image file are stored in the memory 100 of fig 1” (claim 41). In rejecting claim 27, the Office refers to col. 2, paragraph [0018], lines 5-9, of the Nagarajan reference, which discloses

“In addition computing unit 110 is connected to the scanning unit 20 and the image processing unit 70 by way of a control/data bus. In this manner computing unit 110 controls the overall functioning of the system 30 and the flow of image data through the various components.”

Appellants contend that none of the above-cited portions of the Nagarajan reference teach or suggest a file system folder name indicative of a date automatically associated with the digital image, as recited in the various independent claims.

Nor does the Itoh reference remedy the deficiencies of the Nagarajan reference. The Itoh reference is directed to

“a picture postcard such as a New Year's card and the like, in which a customer's recorded image, a background image having a picture associated with the New Year's greetings, predetermined characters and predetermined sentences such as "Happy New Year", "Greeting" and the like associated with the New Year's greetings, and characters such as the address, name and arbitrarily-created sentence and the like of a customer are synthesized, is used as a typical example of a subject to which the image synthesizing method of the present invention is applied.” (col. 1, lines 5-13)

The Itoh reference discloses scanning the image data of an original and storing it in memory (col. 9, line 66 – col. 4, line 4). However, nowhere in the Itoh reference is a file system folder name for the scanned image data disclosed at all, much less as indicative of a date automatically associated with the digital image. It is noted that the Examiner does not cite the Itoh reference as teaching or suggesting this limitation.

Accordingly, there is no teaching or suggestion in the combined Nagarajan and Itoh references of storing the data file into a folder of a file system, the folder having a folder name indicative of the date, as recited in independent claim 11, nor of similar limitations recited in independent claims 27, 35, 37, and 41. Therefore, the Nagarajan and Itoh



references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants' independent claims 11, 27, 35, 37, and 41, nor in their corresponding dependent claims 12-14, 16-25, 28-31, and 34. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be withdrawn.

2. The Examiner has failed to provide a proper suggestion or motivation to combine the teachings of the cited references, in that the Nagarajan reference teaches away from combining with the Itoh reference because, by automatically converting digital images to data files as purportedly taught by the Itoh reference, the user of the Nagarajan reference would undesirably be prevented from confirming the accuracy of the scanned images.

An obviousness rejection requires:

“a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination.” *Ruiz v. A.B. Chance Company*, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004).

To begin with, Appellants note that no application by the Examiner of the Itoh reference is made in the rejections of any of independent claims 11, 35, 37, or 41.

In the rejection of independent claim 27, the Examiner does apply the Itoh reference, and states that it would have been obvious to combine the references “for the purpose wasting little time in the processing of image data by automatically controlling the productivity of the output of the image to increase productivity” (Final Office Action, p.10). Appellants believe that the stated motivation consists merely of a conclusory statement of generalized advantages and convenient assumptions that is too vague and not specific enough to ascertain a motivation for combining the references. Using such a conclusory statement to create the limitations of a claim impermissibly uses Appellants' disclosure as a blueprint in hindsight for the rejection.

In rationalizing the combination of the Nagarajan and Itoh references, the Examiner

states that “Itoh ... teaches converting the digital image into a data file automatically. ... Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the imaging apparatus of Nagaraja[n] to include: converting the digital image into a data file automatically.” (Final Office Action, p.9-10; emphasis added). Appellants disagree. As is argued subsequently by Appellants with regard to claim 1, the Itoh reference does not perform scanning and converting automatically without intervention by a user, as contended by the Examiner. However, assuming arguendo that these operations are performed automatically as the Examiner contends, the Nagarajan and Itoh references would not be properly combinable in that the Nagarajan reference teaches away from such a combination.

The Nagarajan reference is directed to a digital image scanning system for accurately scanning documents (Fig. 1; Abstract). The Nagarajan reference teaches that recommended settings for image mode and image parameters that are generated by the scanning system are intended “to assist a user in adjusting the settings to match the original document (Abstract; emphasis added). It is noted that assisting the user is different from replacing the user, as would occur if digital images are converted to data files automatically without any user confirmation. The accurate image matching of scanned documents to which the Nagarajan reference is directed is generally a subjective exercise, one that is typically best suited to the eye of a human observer. Accordingly, the Nagarajan reference teaches that “the user has the option to adopt the recommended settings” produced by the scanning system (para. [0008]; emphasis added). It goes without saying that the user must therefore also have the option of not adopting the recommended settings, but rather overriding them with different settings that are better suited for producing an accurate document scan.

If digital images were to be automatically converted to data files as the Examiner argues the Itoh reference teaches they are, the user of the Nagarajan reference would undesirably be prevented from confirming the accuracy of the scanned images. The benefits of confirmation, by the discerning eye of a human observer, that the recommended settings are indeed appropriate would be disadvantageously lost if the Nagarajan and Itoh references are combined. Such an undesirable tradeoff is indicative of a lack of motivation to combine.

“Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter” *Winner Int’l Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587. Appellants contend that the loss of user confirmation of the appropriateness of the recommended image settings that would result from combining the Nagarajan and Itoh references, assuming arguendo that such a combination is even feasible, is not desirable on balance and is therefore impermissible. Accordingly, a person of ordinary skill in the art at the time the invention was made would have been dissuaded by the Nagarajan reference from converting the digital image into a data file automatically.

Because the stated motivation to combine is merely conclusory, and because the Nagarajan reference teaches away from combining with the Itoh reference, the Examiner has failed to provide the proper suggestion or motivation necessary to establish a prima facie case of obviousness. Therefore, the rejection is improper at least on these grounds and should be withdrawn.

**B. Claim 15 was improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent application publication 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,034,785 to Itoh ("Itoh").**

Appellants contend that dependent claim 15 was improperly rejected for the reasons discussed heretofore with regard to its base claim 11. In addition, Appellants further contend that dependent claim 15 was improperly rejected because the applied references, alone or in combination, do not teach or suggest all of Appellants’ claim limitations.

Dependent claim 15 recites:

“15. The method of claim 11, wherein the folder name is indicative of a particular month and year.” (emphasis added)

With regard to claim 15, the Examiner states “Nagarajan teaches the method of (fig 1), wherein the data folder is associated with a particular month and year, (PC 50 which is a work station has a function of creating a month and a year in the folder inherently)” (Final Office Action, p.6-7; emphasis added).

The Examiner cites no authority for this assertion of PC 50 creating a month and a year in the folder.

Additionally, and more importantly, the rejection does not address the limitations of claim 15, which recites that the folder name is indicative of a particular month and year. The rejection does not address the name of the folder at all. Neither the Nagarajan reference nor the Itoh reference teach or suggest a limitation wherein the folder name is indicative of a particular month and year. And regardless of to whatever extent, arguendo, a data folder associated with a particular month and year might be inherent, Appellants contend that it would not be inherent to provide a folder name that is indicative of a particular month and year, as recited in claim 15.

The Itoh reference is silent as to folder names.

Therefore, for this additional reason, the Nagarajan and Itoh references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants' dependent claim 15. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be withdrawn.

**C. Claim 32 was improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent application publication 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,034,785 to Itoh ("Itoh").**

Appellants contend that dependent claim 32 was improperly rejected for the reasons discussed heretofore with regard to its base claim 27. In addition, Appellants further contend that dependent claim 32 was improperly rejected because the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations.

Dependent claim 32 recites:

“32. The image processing system of claim 27, wherein the date is an image acquisition date provided by the image source.” (emphasis added)

With regard to claim 32, the Examiner states, with regard to the Nagarajan reference,

that “image scanner unit 20 of fig 1, provides data by scanning image” (Final Office Action, p.12).

However, this rejection does not address the limitations of claim 32, which recites that the date (associated with a digital image from an image source) is an image acquisition date provided by the image source. Neither the Nagarajan reference nor the Itoh reference teach or suggest such a limitation.

Therefore, for this additional reason, the Nagarajan and Itoh references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants’ dependent claim 32. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be withdrawn.

**D. Claim 33 was improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent application publication 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,034,785 to Itoh ("Itoh").**

Appellants contend that dependent claim 33 was improperly rejected for the reasons discussed heretofore with regard to its base claim 27. In addition, Appellants further contend that dependent claim 33 was improperly rejected because the applied references, alone or in combination, do not teach or suggest all of Appellants’ claim limitations.

Dependent claim 33 recites:

“33. The image processing system of claim 27, wherein the date is a current date provided by a date subsystem coupled to the image capture subsystem.” (emphasis added)

With regard to claim 33, the Examiner cites “data subsystem, like computer/workstation 50 of fig 1, connected to image scanning system 30 of fig 1)” of the Nagarajan reference (Final Office Action, p.12).

The relevance of the cited portion of the Nagarajan reference to the claim limitations is unclear. This rejection does not address the limitations of claim 33, which recites that the date (associated with a digital image from an image source) is a current date provided by a

date subsystem coupled to the image capture subsystem. Neither the Nagarajan reference nor the Itoh reference teach or suggest such a limitation.

Therefore, for this additional reason, the Nagarajan and Itoh references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants' dependent claim 33. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be withdrawn.

**E. Claims 1-3, 5-9, 36, and 38 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent application publication 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,034,785 to Itoh ("Itoh").**

Appellants contend that claims 1-3, 5-9, 36, and 38 were improperly rejected because (1) the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations; and (2) there is no suggestion or motivation to modify or combine reference teachings.

1. The cited references, alone or in combination, do not teach or suggest all the limitations of the claims in that the limitation wherein the settings for scanning parameters are not predefined by the user is absent from the references.

The rejection of independent claim 1, and its dependent claims 2-3 and 5-9, is respectfully traversed for at least the following reasons. Claim 1 recites:

“1. A method of optically scanning a target item, comprising:  
configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;  
 initiating a scanning operation;  
 in response to the initiating, optically scanning the target item using the predefined settings to form a digital image of the target item; and  
 converting the digital image into a data file, wherein the scanning and the converting are performed automatically without intervention by a user, and wherein the predefined settings are not defined by the user.” (emphasis added)

The Examiner has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Appellants' claim limitations.

The Examiner admits that "Nagarajan does not expressly teach converting the digital image into a data file, wherein the scanning, and the converting are performed automatically without intervention by the user, and wherein the predefined setting are not defined by the user" (Final Office Action, p.3). However, the Examiner further states that the Itoh reference teaches these limitations.

Appellants disagree that the Itoh reference teaches these limitations. The picture postcard creating system of the Itoh reference synthesizes a picture postcard image from a scanned image of an original, a background image, and greeting text. It is readily apparent upon examination of the specification that the scanning and converting are performed with the intervention of a user (i.e. an operator) rather than automatically, and that the user defines the predefined settings for the scanning parameters. In these aspects, the Itoh reference teaches the opposite of the limitations recited in claim 1.

In the Final Rejection, the Examiner cites col. 14, lines 5-10 in support of the rejection. However, the entire paragraph, not just the portion cited by the Examiner, must be considered in order to fully understand the scanning operation of the Itoh reference:

"In the present invention, a position and a size of a read image (hereinafter, referred to as a scanned image) on a template image are previously designated for each scanned image ... As a result, respective scan images are read by the scanner 12 in response to the designation from the customer's original in accordance with a designated size at the subsequent image scan process F2. The respective scan images having been read are converted into image data having an output resolution of a designated size, for example, 300 dpi and then can be automatically synthesized at a designated position on the template image by the composite processing unit 50 in a subsequent image synthesizing process F4. It is needless to say that the template image is image data having the same output resolution (300 dpi) likewise." (col. 13, line 60 – col. 14, line 10; emphasis added)

The portion (col. 14, lines 5-10) cited by the Examiner is not directed to scanning the image (Fig. 4, block F2), but instead to synthesizing the combined picture postcard image (Fig. 4, block F4). Rather, it is the prior portion of the cited paragraph (col. 13, line 60 – col. 14, line 5) that is directed to scanning the image. This prior portion teaches that the scan images are read by the scanner 12 in accordance with a designated size at image scan process

F2.

Designation, as described in a preceding paragraph of the Itoh reference, is performed by an operator using a data input device 22 (keyboard 22a or mouse 22b, Fig. 1):

“Next, the data input device 22 reads the data stored in the memory device 20, creates a job file in the memory 42 and registers a job by displaying the job file on the monitor 18. In the picture postcard system, the content of the processing executed by the image scan process of F2 shown in FIG. 4 to the content of the processing executed by the bonding process of F7 shown in the figure are registered to the job file for every cases of one lot in the job registration processing. For example, the operator inputs such items of each case as a lot No. case No. handling direction (lengthwise or crosswise), order symbol (type of a template), type of a postal card, number of order, type of a user film, frame No., print magnification and the like or designates them on a job registering screen (register section) of the monitor 18 for creating the job file.” (col. 13, lines 35-50; emphasis added)

The operator designation includes items, such as print magnification, which are used in the scanning process F2:

“First, in the image scan process F2, scan images as many as those registered in the job file are read by the scanner 12 from a negative film or a positive film of the user or from a reflected original in accordance with the job file and a reading size designated by the template attribute file and stored once in the frame memory 46 of the image processing device 15 of the controller 14. Then, the respective scanned images are read from the frame memory 46, subjected to predetermined image processing in the image disposal processing device 48 and converted into image data having the designated size and the output resolution (300 dpi).” (col. 14, lines 33-44; emphasis added)

The print magnification setting chosen by the operator is stored in a “PintMag” [sic] parameter in a Scan section (Table 3, cols. 33-34) of the job file.

Thus, as taught by the Itoh reference, a job file is created in memory and an operator provides parameters for the job, including, as one example, a print magnification setting to be used for scanning the image. Such intervention of the user in defining scan settings is contrary to the limitations of claim 1 which recite that the predefined settings for scanning images are not defined by the user.

It is noted that independent claims 36 and 38 each recite a similar limitation, and have been rejected for similar reasons as claim 1. Therefore, the rejections of claims 36 and 38 are traversed for similar reasons as argued for claim 1.

Therefore, the Nagarajan and Itoh references, taken alone or in combination, do not



teach or suggest the combination of elements recited in Appellants' independent claims 1, 36, and 38, nor in dependent claims 2-3 and 5-9. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be withdrawn.

2. The Examiner has failed to provide a proper suggestion or motivation to combine the teachings of the cited references, in that the Nagarajan reference teaches away from combining with the Itoh reference because, by automatically converting digital images to data files as purportedly taught by the Itoh reference, the chances of obtaining a perfect final image are reduced, not improved.

With regard to independent claim 1, the Examiner contends that it would have been obvious to combine the references "for the purpose of obtaining a perfect final image, for all the prints of different color to be exactly superimpose" (Final Office Action, p.4). The same contention is applied to independent claims 36 and 38 (Final Office Action, p.14,16). Appellants believe that the stated motivation consists merely of a conclusory statement of generalized advantages and convenient assumptions that is too vague and not specific enough to ascertain a motivation for combining the references. In fact, the Examiner's stated motivation is expressly contradicted by the Nagarajan reference, which teaches that user confirmation of the recommended settings, rather than automatic adoption of the user settings, is the desired manner of achieving accurately scanned documents (Abstract; para. [0008]). If the opportunity for user confirmation of the recommended settings is circumvented by automatically converting scanned images to data files, the chances of obtaining a perfect final image are reduced, not improved. Using such a conclusory statement to create the limitations of a claim impermissibly uses Appellants' disclosure as a blueprint in hindsight for the rejection.

In addition, and for similar reasons as explained heretofore with reference to claim 11, the Nagarajan reference teaches away from combining with the Itoh reference in that the loss of user confirmation of the appropriateness of the recommended image settings that would

result from combining the Nagarajan and Itoh references, assuming arguendo that such a combination is feasible, is not desirable on balance and is therefore impermissible.

The Examiner alleges the same motivation with regard to the rejections of independent claims 36 and 38 as for claim 1, and thus Appellants contend that proper motivation is absent for the same reasons as presented for claim 1.

Because the stated motivation to combine is merely conclusory, and because the Nagarajan reference teaches away from combining with the Itoh reference, the Examiner has failed to provide the proper suggestion or motivation necessary to establish a prima facie case of obviousness. Therefore, the rejection is improper at least on these grounds and should be withdrawn.

**F. Claim 4 was improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent application publication 2002/0097452 to Nagarajan ("Nagarajan") in view of U.S. patent 6,034,785 to Itoh ("Itoh").**

Appellants contend that dependent claim 4 was improperly rejected for the reasons discussed heretofore with regard to its base claim 1. In addition, Appellants further contend that dependent claim 4 was improperly rejected because the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations.

Dependent claim 4 recites:

"4. The method of claim 3, further including specifying a date, and wherein the storing further includes storing the data file on the file system in a folder having a folder name indicative of the date." (emphasis added)

With regard to claim 4, the Examiner states "Nagarajan teaches the method (fig 1) further including specifying a date, and wherein the storing further includes storing the data file on the file system in a folder associated with the date, (data file are stored in memory 100 fig 1, via controller 90 and video bus 95 of fig 1, col.2, paragraph 0017, lines 10-15)" (Final Office Action, p.4; emphasis added).

The rejection does not address the limitations of claim 4, which recites that the folder has a folder name indicative of the date. The rejection does not address the name of the

folder at all. As discussed heretofore in considerable detail with regard to independent claim 11, neither the Nagarajan reference nor the Itoh reference teach or suggest a folder name that is indicative of a specified date.

Therefore, for this additional reason, the Nagarajan and Itoh references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants' dependent claim 4. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be withdrawn.

## **VIII. CONCLUSION**

Appellants contend that claims 1-9, 11-25, 27-38, and 41 were improperly rejected because the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations, and because there is no proper suggestion or motivation to combine reference teachings.

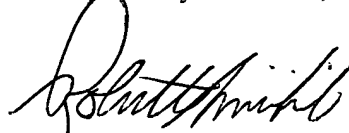
Each of these reasons alone distinguishes Appellants' claims from the cited references and makes Appellants' claims non-obvious in light of the cited references.

Overruling of the Examiner's rejections of claims 1-9, 11-25, 27-38, and 41 is respectfully requested.

**AUTHORIZATION TO PAY AND PETITION  
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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## **IX. CLAIMS APPENDIX**

1. A method of optically scanning a target item, comprising:  
configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;  
initiating a scanning operation;  
in response to the initiating, optically scanning the target item using the predefined settings to form a digital image of the target item; and  
converting the digital image into a data file, wherein the scanning and the converting are performed automatically without intervention by a user, and wherein the predefined settings are not defined by the user.
2. The method of claim 1, further including:  
automatically storing the data file.
3. The method of claim 2, wherein the storing includes storing the data file on a file system.
4. The method of claim 3, further including specifying a date, and wherein the storing further includes storing the data file on the file system in a folder having a folder name indicative of the date.
5. The method of claim 4, wherein the folder name is indicative of a particular month and year.
6. The method of claim 1, wherein the scanning parameters are selected from the group consisting of pixel depth, resolution, crop mode, and skew correction mode.

7. The method of claim 6, wherein the scanning parameter settings appropriate to a photographic image includes:

- pixel depth = 24-bit color;
- resolution = 150 dots per inch;
- crop mode = automatic border detection; and
- skew correction mode = automatic image straightening.

8. The method of claim 4, wherein the file system has no folder having a folder name indicative of the date, further including:

- creating the folder having the folder name indicative of the date.

9. The method of claim 4, wherein the data file is a plurality of data files and wherein the file system has a plurality of folders, further including:

- viewing a representation of the plurality of folders; and
- viewing a representation of the data files in one of the folders.

11. A method of automatically organizing digital images, comprising:

- acquiring a digital image from an image source;
- automatically associating a date with the digital image;
- automatically converting the digital image into a data file; and
- storing the data file into a folder of a file system, the folder having a folder name indicative of the date.

12. The method of claim 11, further including:

- creating the folder if no other folder is associated with the date.

13. The method of claim 11, wherein the date is the capture date when the image was captured by the image source.

14. The method of claim 11, wherein the date is the storage date when the image was converted into a data file.

15. The method of claim 11, wherein the folder name is indicative of a particular month and year.

16. The method of claim 11, wherein the folder is selected from a set of folders.

17. The method of claim 11, wherein the digital image is a previously captured image, and wherein the acquiring further includes:  
uploading the previously captured image.

18. The method of claim 11, wherein the acquiring further includes:  
predefining settings for image acquisition parameters appropriate to a photographic image; and  
capturing the digital image with the image source according to the predefined settings.

19. The method of claim 11, further comprising:  
performing a post-processing operation on the data file.

20. The method of claim 19, wherein the performing includes performing an image polishing operation.

21. The method of claim 19, wherein the performing includes processing the data file with an application program.

22. The method of claim 21, wherein the performing further includes sending the processed data file to a destination.

23. The method of claim 22, wherein the destination is a peripheral device.

24. The method of claim 23, wherein the peripheral device is selected from the group consisting of a printer and a fax machine.

25. The method of claim 21, wherein the application program is selected from the group consisting of an image polishing application, a creative printing application, a photo album application, an e-mail application, and a photo web site upload application.

27. An image processing system, comprising:

at least one image source, each image source for providing at least one digital image upon request;

an image capture subsystem coupled to the at least one image source for requesting and receiving the at least one digital image from the at least one image source, the image capture subsystem further for associating a date with each digital image and automatically converting each digital image into a corresponding image file; and

a file system coupled to the image capture subsystem for automatically storing each image file in a selected one of a plurality of data folders, the selected data folder having a folder name indicative of the date.

28. The image processing system of claim 27, comprising:

an image management subsystem coupled to the image capture subsystem and the file system for viewing the plurality of data folders and the image files in a specified data folder.

29. The image processing system of claim 28, comprising:

a post-processing subsystem coupled to the image management subsystem for post-processing at least one selected one of the image files.

30. The image processing system of claim 29, wherein the post-processing subsystem



is further coupled to the file system for accessing the selected ones of the image files.

31. The image processing system of claim 29, comprising:  
an image destination coupled to the post-processing subsystem for receiving output data corresponding to at least one selected one of the image files.

32. The image processing system of claim 27, wherein the date is an image acquisition date provided by the image source.

33. The image processing system of claim 27, wherein the date is a current date provided by a date subsystem coupled to the image capture subsystem.

34. The image processing system of claim 27, wherein the at least one image source is an optical scanner, and wherein the image capture subsystem provides predefined settings appropriate to a photographic image to the optical scanner for use in providing the at least one digital image.

35. A processor-readable medium having processor-executable instructions thereon which, when executed by a processor, cause the processor to:  
acquire a digital image from an image source;  
automatically convert the digital image into a data file having a date associated with the digital image; and  
store the data file into a data folder of a file system, the folder having a folder name indicative of the date.

36. A processor-readable medium having processor-executable instructions thereon which, when executed by a processor, cause the processor to:  
configure an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;

detect an initiation of a scanning operation;  
in response to the initiation, optically scan the target item using the predefined settings to form a digital image of the target item; and  
convert the digital image into a data file, wherein the instructions to scan and convert are performed automatically after the initiation without intervention by a user, and wherein the predefined settings are not defined by the user.

37. An image processing system, comprising:  
means for acquiring a digital image from an image source;  
means for automatically converting the digital image into a data file having a date associated with the digital image; and  
means for storing the data file into a data folder of a file system, the folder having a folder name indicative of the date.

38. An image processing system, comprising:  
means for configuring an optical scanning arrangement with predefined settings for scanning parameters appropriate to a photographic image;  
means for initiating a scanning operation;  
means for optically scanning the target item using the predefined settings to form a digital image of the target item; and  
means for converting the digital image into a data file, wherein the scanning and the converting are performed automatically without intervention by a user, and wherein the predefined settings are not defined by the user.

41. An image processing system, comprising:  
at least one image source, each image source for providing at least one digital image upon request;  
an image capture subsystem coupled to the at least one image source which requests and receives the at least one digital image from the at least one image source, associates a

date with each image, and automatically converts each image into a corresponding image file;  
and

a file system coupled to the image capture subsystem which receives each image file from the image capture subsystem and automatically stores each image file in a selected one of a plurality of data folders, the selected data folder having a folder name indicative of the date.

## **X. EVIDENCE APPENDIX**

None

## **XI. RELATED PROCEEDINGS APPENDIX**

None